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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,125	02/19/2004	John A. Calabria	DSCK-1214-C3	1212

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08/03/2005

LORUSSO LOUD & KELLY LLP  
PEASE INTERNATIONAL TRADEPORT  
SUITE 312  
15 RYE STREET  
PORTSMOUTH, NH 03801

EXAMINER

GORDON, RAEANN

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/783,125	<b>Applicant(s)</b> CALABRIA ET AL.	
	<b>Examiner</b> Raeann Gorden	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-16, 20, 22-28 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-16, 20, 22-28 and 33-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5-16-05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group 1 in the reply filed on 4-25-05 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 27 depends from a canceled claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 13, 20, 22-28, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dewanjee (WO 98/37929) in view of Pocklington (4,932, 664) and Strictly Golf Balls. Dewanjee discloses a three-piece golf ball. The core comprises a rubber center and a thread layer (pg 12, lines 24-28). A cover surrounds the core (fig

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11). The polyurethane cover has a Shore D hardness from 50 to 65 and is made from a slow-reacting diamine and a fast-reacting diamine (abstract; pg 15, line 12). The slow reacting diamine is dimethylthio- 2, 4-toluenediamine and the fast reacting diamine is diethyl-2,4- toluenediamine (abstract). The polyurethane cover includes toluene diisocyanate and polytetramethylene ether glycol (pg 5, lines 1-3). The cover thickness is 0.05 inch (pg 12, line 34-pg 13, line 5,  $(1.68-1.58)/2$ ). Dewanjee does not disclose dimples on the cover arranged in a polygonal configuration. However, Pocklington et al teaches a cover with dimples. The dimples are arranged within polygonal configurations including triangles, pentagons, and trapezoids (abstract). Applicant's square is equivalent to a trapezoid since both are four sided polygons and serve the same purpose. One skilled in the art would have modified the cover of Dewanjee with the dimple pattern of Pocklington to achieve the desired flight characteristics.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dewanjee (WO 98/37929) in view of Pocklington (4,932, 664) as applied to claims -4, 6, 13, 20, 22-28, and 33-35 above, and further in view of Maruko (5,823,888). Dewanjee discloses a thread layer of 0.16 inch but does not disclose the thickness of the thread layer from 0.20 to 0.26 inch (page 12, lines 33-34). Maruko teaches a golf ball comprising a solid core, thread layer, and cover wherein the thread layer has a thickness from 4 to 11 mm or 0.16 to 0.43 inch (see col 3, lines 6-7 and 45-46 for diameters of core and thread layer). One of ordinary skill in the art would have increased the thickness of the thread layer for increased durability.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dewanjee (WO 98/37929) in view of Pocklington (4,932, 664) as applied to claims 1-4, 6, 13, 20, 22-28, and 33-35 above, and further in view of Strictly Golf Balls. The PGA compression of the ball from 70 to 100 is an obvious feature of all golf balls. Strictly Golf Balls teaches compression ratings of 80, 90, and 100 and values outside this range are usually discarded, sold as range ball, or sold as X-OUTS (see Strictly Golf Balls Sheet).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 10-16, 20, 22-28, and 33-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,719,646. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention and the '646

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patent claim three-piece golf balls comprising a core, a thread layer, and a polyurethane cover. Rearranging the limitations does not render a patentable distinction.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 571-272-4409. The examiner can normally be reached on Mon, Tues, Thurs, Fri 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rg  
July 11, 2005

  
**RAEANN GORDEN**  
**PRIMARY EXAMINER**